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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,766	01/19/2000	Veronique Mahe	ROC-17	8806

7590 03/18/2002

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EXAMINER
FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 03/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/483,766	MAHE ET AL.	
	Examiner	Art Unit	
	Blessing M. Fubara	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02/14/02* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Examiner acknowledges receipt of paper number 15 filed 02/14/02.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

All three inventors failed to supply the date of execution of the declaration.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim claims 1 and 4 recite the broad recitation of the whole body and at least one fragrance respectively, and the claims also recite "in particular for the sensitive parts of the human body" and "glacier SG 809 A" respectfully which is the narrower statement of the range/limitation.

The recitation in claims 4 and 18 of "glacier SG 809 A" confusing. "Glacier SG 809 A" appears to be trade name. Claims 4 and 18 contain the trademark/trade name Glacier SG 809 A. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a particular type of fragrance and, accordingly, the identification/description is indefinite.

No evidence has been submitted to support a wide use of the term in the United States and other places. Applicants are required to use the appropriate non-trade mark term defining the particular fragrance in the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admitted prior art in view of Koga (JP 10,231,238).

Applicants admit that menthyl lactate and menthol are used in cosmetic and pharmaceutical compositions. Applicants are also aware that menthol concentrations in compositions at the level (1.25% to 16%) recommended by the Food and Drug Administration (FDA), impart strong flavor and consumers do not appreciate the strong odor and thus such compositions. Applicants are also aware that menthol posses freshening and anti-irritant properties. See pages 1 to 3 of the disclosure.

Koga in JP 10,231,238 teaches a cosmetic composition that is prepared by adding 0.001-10.0 weight percent of menthol and at least one of menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane (abstract).

Applicants are aware that high concentrations of menthol in a composition cause undesired response from consumers. Applicants are aware that menthol possesses anti-irritant properties. Koga in JP 10,231,238 teaches a cosmetic composition comprising lower concentrations of menthol than that recommended by FDA. Although, the combined teaching of applicants' prior knowledge and Koga does not provide a composition comprising a

menthol/menthyl lactate range of from about 1/3 to about 1/10, no unexpected result is presented as to why a composition comprising those particular ranges is critical.

It is the examiner's position that the state of the art is such that one of ordinary skill in the art would know routine procedure for testing different concentrations ratios of menthol and menthyl lactate (or menthyl glycoside, menthyl hydroxybutyrate, menthoxypropanediol and menthoxyfurane) to provide a composition that is not irritating to the human body. It would have been obvious to a person having ordinary skill in the art, at the time the invention was made, to employ ones knowledge of the sate of the art in the manner taught by Koga. One having ordinary skill in the art would have been motivated to prepare a freshening cosmetic composition that has menthol and menthyl lactate, menthyl glycoside menthyl hydroxybutyrate, menthoxypropanediol or menthoxyfurane in the appropriate concentrations so that the composition is not irritating to the human body. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is not inventive over JP 10, 231,238 in the absence of a showing of criticality of the claimed concentrations of menthol and menthyl lactate. In the absence of unexpected result, a composition comprising menthol/menthyl lactate range of from about 1/3 to about 1/10 is not critical over the composition of the prior art.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowler et al. (5,534,265).

Fowler discloses a cleansing composition comprising menthol, menthyl lactate, sodium lauryl sulfate, sodium laureth sulfate, cetyl dimethyl betaine, sodium cocoyl isethionate, glycerin,

polyethylene glycols, fragrance, anti-oxidants, preservatives, polyquaternium-10, propoxylated glycerol, carboxymethyl cellulose and hydroxypropylcellulose. Fowler teaches a cleansing composition comprising 0.1% to 10% menthol and menthyl lactate. It is the examiner's position that the state of the art is such that one of ordinary skill in the art would know routine procedure for testing different concentrations of menthol in combination with different concentrations of menthyl lactate or any of the other compounds listed by Fowler to provide a composition that is not irritating to the human body. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Fowler. One having ordinary skill in the art would have been motivated to prepare the composition of Fowler. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). A menthol/menthyl lactate range of from about 1/3 to 1/10 is not inventive over the prior art in the absence of unexpected result.

5. Applicants' cooperation is requested in correcting any errors of which applicants may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is 703-308-8374. The examiner can normally be reached on 7 a.m. to 3:30 p.m. (Monday to Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Blessing Fubara
March 12, 2002

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600